

Application No. 09/486,037

REMARKS

Claims 1, 6-7, 10-12, 20-28 and 31 are pending in this application. By the Office Action, claims 1, 2, 4-12, and 19-31 are rejected, and claims 20-28 are allowed. By this Amendment, claim 1 is amended and claims 2, 4-5, 8-9, 19 and 29-30 are canceled. Support for amended claim 1 can be found in the original claims as filed, thus no new matter is added. In view of the foregoing amendments and the following remarks, reconsideration and allowance are respectfully requested.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issue requiring further search and/or consideration (since the amendments amplify issues previously discussed throughout prosecution); (c) satisfy a requirement of form asserted in the previous Office Action; (d) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (e) place the application in better form for appeal, should an appeal be necessary.

In particular, claim 1 is merely amended to incorporate the features of claim 5, which was indicated in the October 23, 2002 Office Action to be free of the prior art and is not rejected over prior art in the present Office Action. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

Applicant thanks the Examiner for the indication that claims 20-28 contain allowable subject matter.

I. Rejection under §102**A. Kaneko**

The Office Action rejects claims 1-4 and 6-8 under 35 U.S.C. §102(b) over U.S. Patent No. 5,272,072 to Kaneko et al. ("Kaneko"). Claim 1 is amended to recite the features

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of dependent claim 5, which is not rejected on this basis. Therefore, the rejection should be reconsidered and withdrawn.

B. Wong-Madden

The Office Action rejects claim 19 under 35 U.S.C. §102(e) over U.S. Application Publication 2002/0137176 to Wong-Madden ("Wong-Madden"). Applicant cancels claim 19 herein, thus rendering this rejection moot. Accordingly, the rejection should be withdrawn.

II. Rejection under §112, first paragraph

The Office Action rejects claims 1-2, 4-12, 19 and 29-31 under 35 U.S.C. §112, first Paragraph. The Office Action alleges that claim 1, as previously amended in the April 23, 2003 Amendment, contained new matter. Specifically, the Office Action alleges that the specification does not support a genus of compounds that inhibit hexosaminidase while excluding formamide. Amended claim 1 does not recite such a genus.

As detailed above, amended claim 1 is directed to a culture medium featuring an acetamide that selectively inhibits the hexosaminidase activity of *C. tropicalis*. The original specification and claims support claim 1 and claims 6-7, 10-12 and 31 all depend from claim 1. Thus, none of the claims recite new matter. Claims 2, 4-5, 8-9, 19 and 29-30 are canceled, thus rendering their rejection moot.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection.

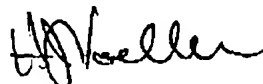
III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 6-7, 10-12, 20-28 and 31 are earnestly solicited.

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Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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